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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,498	02/05/2001	John Michael Jensen		9282

7590 04/15/2004

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EXAMINER

VIG, NARESH

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/776,498

Applicant(s)

JENSEN, JOHN MICHAEL

Examiner

Naresh Vig

Art Unit

3629



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 20 is/are rejected.
- 7) ☒ Claim(s) 9, 16 - 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

The amendment filed 08 December 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

For example, Amendment to specification new matter "900" numbers which is not supported by the original application;

Amendment to specification new matter "spam" which is not supported by the original application.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Objections***

Claims 9 and 16 – 18 are objected to because of the following informalities: Claims 9 and 16 – 18 recite system and method. Examiner reads claims 9 and 16 – 18 as method claims because the body of the claim recites method steps. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9, 14 and 16 – 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For example, claim 9 recites one or more unique sites for receiver which is not supported by the application.

Claims 16 – 18 are claims dependent on claim 9.

Claim 14 recites receiver party is compensated with consideration other than money which is not supported by the application.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 recites "method of claim 1 wherein the steps or processes are automated or performed automatically". Claim 19 does not disclose which steps of claim 1 are performed automatically, because the input steps of claim 1 is a manual process where a user has to input some information to make a selection.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 recites "method of claim 1 wherein the steps or processes of the method may be taken in different orders or sequences or performed simultaneously". Claim 20 does say which steps can be performed simultaneously.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 8, 12, 15, 19 and 20 are rejected under 35 U.S.C. 102(e) as being unpatentable over Keen.com, Inc. hereinafter known as Keen.

Regarding claim 1, Keen discloses system and method for using a computer to enable or to facilitate communication between 2 or more parties in which a party pays a fee, bears a cost, or provides consideration which benefits in part the receiving party [page 40 – 43]. Keen discloses:

utilizing a network presence (Keen works over the internet);

inputting into the computer search terms or information, including by the use of clicks on hypertext links, to search for or to locate an address, account, location, or reference identification associated with a specific party to receive the communication [page 7];

inputting into the computer information that creates, formats, forwards, edits, modifies, addresses, or directs a communication or transmission [page 7, 10];

inputting into the computer a payment identifier, account information, security code, or other information to enable a party to pay for, to assume a cost or obligation, to charge or otherwise to bill, to account, to debit, to access benefits, to license, or otherwise to transfer benefits or consideration that in whole or in part benefit a receiver party [page 10, 36];

segregating, transmitting, storing, holding, distributing, or passing through transmissions or communications directed to an account, address, or location associated with a specific receiver, account, or address [page 10];

compensating party who receives communications or participates in the method [page 42].

Regarding claim 2, Keen discloses utilizing a network presence. Keen discloses:  
establishing a network presence on one or more networks, computers, or devices  
(Keen provides access over the internet);

establishing unique addresses, accounts, mailboxes, pass-through means, or  
other identifiers or repositories for parties to receive communications or transmissions  
[page 9]; and

providing a network accessible searchable database or information display or  
interface to enable a party to browse, to search for, to locate, or to find an address,  
account, location, or reference identification associated with a specific party to receive  
the communication; and providing additional information, pages references, links, or  
other data about or concerning the receiver party or its associations [page 7].

Regarding claim 3, Keen discloses inputting into the computer search terms or  
information to search for or to locate the address, account, location, or reference  
identification associated with a specific party to receive the communication [page 7, 10].  
Keen discloses:

establishing unique addresses, accounts, mailboxes, pass-through means, or  
other identifiers or repositories for parties to receive, store, or access communications  
or transmissions [page 9];

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verifying, checking, or authenticating that the specific parties to receive the communication are authentically associated with the commonly known party most often or commonly associated in the public's mind with the name or association of the name given as a party intending to receive communication [page 9];

Providing a means to search, find, locate, identify, and access addresses, accounts, locations, or reference identifications associated with a specific party to receive the communication or transmission [page 9];

Providing additional information about the receiver party or its associations [page 12].

Regarding claim 4, Keen discloses inputting into the computer search terms or information to search for or to locate the address, account, location, or reference identification associated with a specific party to receive the communication. Keen discloses:

establishing addresses, accounts, locations, reference identifications, identifiers, channels, codes, e-mail addresses, web site addresses or pages, storage accounts, or other repositories, pass-through accounts, addresses, sites, or means for parties to receive or to store communication or transmission [page 9];

organizing the addresses, accounts, locations, reference identifications, identifiers, channels, codes, e-mail addresses, web site addresses or pages, storage accounts, or other repositories, pass-through accounts, addresses, sites or means so



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that they can be searched and located by the name or association of the parties to receive the communication or transmission [page 7, Keen discloses information can be grouped together based upon business requirements];

providing a means to search, find, locate, identify, and access addresses, accounts, locations, or reference identifications associated with an account or address associated with a specific party to receive the communication or transmission [page 7, 10].

Regarding claim 5, Keen discloses inputting into the computer information that creates, formats, forwards, edits, modifies, addresses, or directs a communication or transmission. Keen discloses:

Providing services or means to enable parties to input information such as text, audio, or graphics or to create, to format, or to direct communications, e-mail, or transmissions [page 10].

Regarding claim 6, Keen discloses inputting into the computer a payment identifier, account information, security code, or other information to enable parties to pay for, to assume a cost or obligation, to charge or otherwise to bill, to account, to debit, to access benefits, to license, or otherwise to transfer benefits or consideration comprises [page 10]:

Establishing terms, conditions, and legal agreements between the parties [page 40 – 43];

Inputting or enabling parties to input into the computer information to accept or to form a legally binding contract or agreement between the parties [page 36, 40 – 43];

providing services or means to enable one or more parties to pay for, to assume a cost or obligation, to charge or otherwise to bill, to account, to debit, to access benefits, to license, to provide consideration, or otherwise to compensate or benefit one or more other parties page 10, 40 – 43];

providing services or means to process payment, to transact financial transfers, to authenticate or authorize transactions, to charge a party a fee or cost, to receive payment and consideration, to segregate consideration received, to account for consideration received, or otherwise to enable a party to provide or to transfer consideration [page 41].

Regarding claim 7, Keen discloses segregating, transmitting, storing, holding, distributing, or passing through transmissions or communications directed to an account, address, or location associated with a specific party, receiver, account, or address. Keen discloses:

Segregating, storing, holding, or directing transmissions or communications directed to a specific receiver party in or to an account, location or address associated with a specific receiver party [page 32];

transmitting, passing through, or distributing communication to Receiver parties or to an account or address or location associated with receiver party on or corresponding to a receiver party's request or agreement to access or receive communication [page 32, 33].

Regarding claim 8, Keen discloses compensating party who receives communications or participates in the method comprises:

Receiving, authorizing, and segregating financial and beneficial transfers; accounting for fees, revenues, costs, and other items [page 41];

transmitting, storing, holding, or distributing communication to receiver parties or to an account or address or location associated with receiver [page 32];

enabling parties that have received communication to access the communication by enabling the parties to download, read, view, or otherwise access the communication [page 32];

compensating or paying parties that have received communication or participated for his or her or their reception, participation, or per agreement [page 41].

Regarding claim 10, Keen discloses party is referred or delivered directly to a page, address, account, or location associated with a receiver party such that the party

does not have to input or to search for or locate the page, address, account, or location associated with a receiver party [page 10].

Regarding claim 11, Keen discloses method wherein the party does not have to input or enter any information or data relating to the address, account, or content of the communication because the communication is pre-existing or automatically directed, forwarded, transmitted, or otherwise addressed or sent to the address or account corresponding to the specific receiver party (keen makes connection between use and offering member) [page 38].

Regarding claim 12, Keen discloses method wherein the party does not have to enter any payment identifier, account information, security code, or other information to enable the party to access an existing account, to transfer payment, or to provide consideration because the party's computer or other device, for example by use of cookies or other means, automatically provides this or other information [page 10].

Regarding claim 15, Keen discloses method wherein the receiver party may set the terms, price, and conditions of the agreement or communication [page 12].

Regarding claim 19, Keen discloses some of the steps being automated or performed automatically [page 42, Keen collect payment, charge 30% and pay balance to the offering member etc.]

Regarding claim 20, Keen discloses steps or processes of the method may be taken in different orders or sequences or performed simultaneously [page 7, customer can first perform search using text followed by searching using categories, or, vice versa.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keen.com, Inc. hereinafter known as Keen in view of 1stUP.com hereinafter known as 1stUP.

Regarding claim 13, Keen does not disclose method wherein the party does not have to pay fees, or bear a cost because a third party provides consideration or compensation that benefits the receiver party (access to the services is paid for by a sponsor). However, Keen discloses that their minimum charge for providing services is 5 cents per minute, and, it is the offering member who set what fees to charge the user. 1stUP discloses to provided free service to users where the access charges are provider by a sponsor [page 5]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Keen as taught by 1stUP to make the system a system of choice among users.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Naresh Vig  
March 24, 2004